

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on April 9, 2001, and the references cited therewith.

No claims are amended, canceled, or added; as a result, claims 1-18 remain pending in this application.

§102 Rejection of the Claims

Claims 1-4 and 8-18 were rejected under 35 USC § 102(e) as being anticipated by Schultheiss (US 6,208,384). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully traverses the rejection, because the cited reference does not disclose each and every element of the claimed invention as arranged in claims.

As an example of at least one element not found in Schultheiss, each of the independent claims 1, 8, 12 and 16 recite elements including a pointing device. The Office Action asserts that element 50 of Schultheiss teaches a pointing device. Applicant notes that element 50 is in fact labeled a "wireless remote", not a pointing device (see column 5, lines 23-30). While the device does include a trackball, the only use disclosed for the trackball appears to be to control an on-screen television guide (see column 5, lines 59-65). It does not function as a general purpose pointing device as such pointing devices are known in the art.

Same thing
See
Col 5,
lines
59-65

Claims 2-4, 9-11, 13 and 17-18 each depend from claims 1, 8, 12 and 16 respectively. They therefore inherit the elements of their respective base claims and provide further patentable distinctions. They are therefore not anticipated for the same reasons as detailed above for their

respective base claims.

Even if wireless remote 50 was a pointing device (which is not admitted), Schultheiss still fails to teach or disclose each and every element of Applicant's claims. For example, claim 1 recites "a pointing device operatively coupled to the computer and having at least one control to control only the multimedia device, wherein the pointing device only couples to the computer ...". The Office Action appears to ignore the language recited in claim 1 that the pointing device "only couples to the computer." As clearly shown in Schultheiss in FIG. 1 and the accompanying description at column 5, lines 31-44, the wireless remote 50 couples both to computer 12 and television 40. Thus the device does not only couple to the computer, and Schultheiss fails to teach or disclose each and every element of claim 1.

A further example of a claim element not taught or disclosed by the cited reference is found in independent claim 8, which recites "a pointing device having at least one control to control only the multimedia device such that actuation of a control causes the computer to change a functionality of the multimedia device associated with the control" (emphasis added). Dependent claims 2, 13 and 18 each recite similar language. The Office Action asserts that button 62 teaches such a control. Applicant respectfully disagrees with this interpretation of the reference. Applicant notes that the button 62 on wireless remote 50 does not cause the computer to change a functionality, rather the wireless remote operates directly on television 50 through the infrared interface 72. (see column 5, lines 54-65).

For the above reasons, Schultheiss does not teach or disclose each and every element of Applicants claims 1-4 and 8-18. Applicant respectfully requests that the Examiner withdraw the rejection of the claims.

§103 Rejection of the Claims

Claim 5 was rejected under 35 USC § 103(a) as being unpatentable over Schultheiss as applied to claim 1, and further in view of Frank (EP 1 1596 594). Applicant respectfully traverses the rejection, because the Office Action does not present a *prima facie* case of obviousness with respect to the claim 5.

In order to establish a *prima facie* case of obviousness, three base criteria must be met.

it's
a
wireless
remote
it's too
low
to control
the television
furthermore
the
alternately
controlled
FIG 4
↓

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the cited references do not teach or disclose each and every element of Applicant's claim 5.

Claim 5 inherits the elements of its respective base claim 1. As noted above, Schultheiss fails to teach or disclose language recited in independent claim 1, specifically "wherein the pointing device only couples to the computer." Frank also fails to teach the recited language. The control device 30 in Frank couples both with computer 34 and with target devices 48 and 50 (see column 5, lines 25-43). As result, neither Schultheiss nor Frank, alone or in combination, teach each and every element of Applicant's claims. Therefore, a *prima facie* case of obviousness has not been established and the rejection of claim 5 is improper.

Claims 6 and 7 were rejected under 35 USC § 103(a) as being unpatentable over Schultheiss as applied to claim 1, and further in view of Redford (US 5,339,095). Applicant respectfully traverses the rejection, because the Office Action fails to present a proper *prima facie* case of obviousness. As discussed above, the Examiner has the burden to provide a motivation to combine the references cited in an obviousness rejection. The Office Action rejects claims 6 and 7 using the combination of Schultheiss and Redmond, but asserts a motivation to combine Schultheiss and Frank, apparently repeating the motivation to combine used in the rejection of claim 5. No motivation to combine Schultheiss and Redmond is provided. Applicant respectfully requests the withdrawal of the rejection of claims 6 and 7, or alternatively that the Examiner provide a proper grounds for rejecting claims 6 and 7.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Title: AUDIO AND VIDEO CONTROLS ON A POINTING DEVICE FOR A COMPUTER

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Dkt: 450.156US1

notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

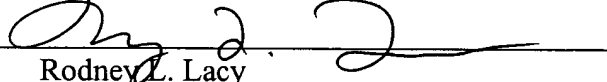
Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this day of July 9, 2001.

Name Patricia A. Hultman Signature 